

REMARKS

In the Final Office Action dated April 7, 2006, the Examiner refused to consider the merits of the two pending claims, claims 61 and 62. Instead, the Examiner withdrew claims 61 and 62 from consideration, contending that these claims were "directed to a non-elected invention". The only stated basis for this unilateral withdrawal of claims 61 and 62 was that these claims "recite [the] new process step of 'obtaining precipitated calcium carbonate'". (Final Office Action, page 2).

The Examiner's action is without proper basis. In the prior Office Action (dated November 23, 2005), the Examiner rejected the only claim, claim 59, saying that it covered the "USE and the METHOD OF MAKING of recycled calcium carbonate." (Office Action, page 3, underlining added). Clearly, the Examiner read claim 59 and believed that it covered (1) using calcium carbonate (in treating paper), and (2) a method of making calcium carbonate. Presumably, the Examiner performed his search with that understanding, even though he indicated that a claim cannot properly contain both of these aspects. New claim 61 was added in the Amendment dated March 13, 2006 to be directed to a method of using calcium carbonate in treating paper, and new claim 60 was added in the Amendment dated March 13, 2006 to be directed to a method of making calcium carbonate. Thus, the two inventions that were originally together in claim 59 were separated into new claims 60 and 61.

The citations to the MPEP AND CFR relied upon by the Examiner do not support the Examiner's action. In the current Office Action, the Examiner relies upon the following MPEP and CFR sections:

821.03 Claims for Different Invention Added After an Office Action

Claims added by amendment following action by the examiner, MPEP §818.01, §818.02(a), to an invention other than previously claimed, should be treated as indicated by 37 CFR 1.145.

37 CFR 1.145 Subsequent presentation of claims for different invention

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§1.143 and 1.144.

Since the prior claim (claim 59) covered the SAME invention as recited in claims 60 and 61, the Examiner's rejection is improper. The fact that claims 60 and 61 are subsumed in original claim

59 is further established by comparing the wording of the claims side by side, as shown in the tables below:

| Claim 59 (Now cancelled)* | Claim 60 (pending) |
|---|--|
| 59. Use of recycled calcium carbonate in the treatment of a paper, board or nonwoven product, said calcium carbonate being prepared by [calcining] | 60. A method of making calcium carbonate for use in the treatment of a paper, board or nonwoven product, comprising: |
| the precipitated calcium carbonate residue of the deinking process of recycled fiber | obtaining precipitated calcium carbonate residue from a deinking process of recycled fiber; |
| calcining [the precipitated calcium carbonate residue of the deinking process of recycled fiber] into lime, reacting the lime with water into calcium hydroxide and | calcining the precipitated calcium carbonate residue to form lime; |
| reacting the calcium hydroxide thus formed with carbon dioxide into calcium carbonate | reacting the lime with water to form calcium hydroxide; and |
| so that particles can be formed having an average particle size so small as to permit the particles to adhere to each other by van der Waals forces. | reacting the calcium hydroxide with carbon dioxide to form calcium carbonate. |

| Claim 59 (Now cancelled)* | Claim 61 (pending) |
|---|---|
| 59. Use of recycled calcium carbonate in the treatment of a paper, board or nonwoven product, said calcium carbonate being prepared by [calcining] | 61. A method of treating a paper, board or non-woven product, comprising: |
| the precipitated calcium carbonate residue of the deinking process of recycled fiber | obtaining precipitated calcium carbonate residue from a deinking process of recycled fiber; |
| calcining [the precipitated calcium carbonate residue of the deinking process of recycled fiber] into lime, reacting the lime with water into calcium hydroxide and | calcining the precipitated calcium carbonate residue to form lime; |
| reacting the calcium hydroxide thus formed with carbon dioxide into calcium carbonate | reacting the lime with water to form calcium hydroxide; |
| [Use of recycled calcium carbonate in the treatment of a paper, board or nonwoven product,] | reacting the calcium hydroxide with carbon dioxide to form calcium carbonate; and |
| so that particles can be formed having an average particle size so small as to permit the particles to adhere to each other by van der Waals forces. | applying the formed calcium carbonate to a paper, board or non-woven product. |

* Brackets [] reflect that the bracketed claim language was repeated in the comparison table twice.

The Examiner's allegation that the step of "obtaining precipitated calcium carbonate" is "new" is also without basis. Original claim 59 stated that precipitated calcium carbonate was to be used, specifically, that the precipitated calcium carbonate was calcined. To use (or calcine) the precipitated calcium carbonate, clearly one must obtain it first, otherwise there is nothing to be calcined. The "obtaining" step was thus an inherent part of original claim 59 and is not a "new process step" as alleged by the Examiner.

For the above reasons, applicants respectfully request retraction of the Examiner's withdrawal of claims 61 and 62 from consideration, and consideration of these claims on the merits.

It is also submitted that the claims are patentable, and this application is in condition for allowance. Such action is respectfully requested.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

COHEN, PONTANI, LIEBERMAN & PAVANE

By



Michael C. Stuart

Reg. No. 35,698

551 Fifth Avenue, Suite 1210

New York, New York 10176

(212) 687-2770

Dated: June 6, 2006